

REMARKS

This is a full and timely response to the Official Action mailed on. Reconsideration of the application in light of the following remarks is respectfully requested. Claims 1-4, 9, 10, 12-19 and 25 are currently pending.

In the recent Office Action, claims 16-19 and 25 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. (Paper No. 11, p. 2) For at least the following reasons, this rejection is traversed.

Clearly, it *cannot* be argued that one of skill in the art asked to package the recited elements in a “kit” would be unable to do so. Claims 16-19 and 25 are clearly enabled to those skilled in the art who would certainly know how to package the recite elements together to form a kit.

More relevant is the issue of whether the Applicant is allowed to recite that the elements are packaged together to form a kit and the weight to be given those recitations. As has been established in the examination, there are a range of definitions for the term “kit” from a narrow definition (i.e., a set of material packaged together for sale) to the “broadest reasonable” definition (i.e., “a set of article or implements used for a specific purpose”). (Paper No. 6, p. 9).

Applicant did not expressly define the term “kit” in the specification and therefore relies on the various common definitions of that word in the art. It cannot be disputed that one of those common definitions is a set of materials packaged together. Therefore, Applicant is entitled, if Applicant so chooses, to restrict the claims to that particular definition of kit, which is entirely consistent with Applicant’s specification. This is what the Applicant has done.

The recent Office Action states that what “is most important is the definition which is most reasonable with applicant’s disclosure, and in this instance, it is the broadest definition which defines a kit as a set/collection of articles or implements.” (Paper No. 11, p.3). This is incorrect.

If a term is not defined in the claim or the specification, the examination will give the term its broadest reasonable interpretation. However, if the Applicant then amends the claim

to narrow the definition, the terms of the amended claim must then be examined and given full weight. Otherwise, Applicant has no real ability to amend the claim. A term in a claim cannot be construed in a manner broader than, and contrary to, the express definition of the term recited in that same claim. This point is made expressly in the MPEP: "During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< [However,] Applicant always has the opportunity to amend the claims during prosecution." MPEP § 2111.

Therefore, Applicant has a right to amend claims 16-19 and 25 to recite a particular definition of the term "kit." Consequently, these claims now expressly recite a kit that is a set of elements "packaged" together. Moreover, because claims 16-19 and 25 are clearly enabled to one of skill in the art, the rejection under 35 U.S.C. § 112, first paragraph, should be reconsidered and withdrawn. Notice to this effect is respectfully requested.

With regard to the prior art, the recent Office Action rejected claims 12-14 as anticipated under 35 U.S.C. § 102(b) of U.S. Patent No. 6,284,339 to Floegel et al. ("Floegel"). For at least the following reasons, this rejection is respectfully traversed.

Claim 12 recites:

An electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium;
an electrostatic charge deposited on a side of said sticker print medium; and
a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.

In contrast, Floegel fails to teach or suggest "an electrostatic charge deposited on a side of said sticker print medium; and a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium." Rather, Floegel teaches an electret sheet having a "permanent electrostatic charge" that is a characteristic of the material and processing from which the sheet is made. (Col. 1, lines 57-63). Therefore, Floegel does not

teach or suggest a charge “deposited on a side” of the sticker medium and does not teach or suggest a protective cover “over said electrostatic charge.”

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Floegel cannot anticipate claim 12. Thus, the rejection of claim 12 and its dependent claims, based solely on Floegel, should be reconsidered and withdrawn.

The recent Office Action also rejects claims 12-15 as anticipated under 35 U.S.C. § 102(b) by Longtin (“Longtin”). For at least the following reasons, this rejection is respectfully traversed.

Longtin also fails to teach or suggest “an electrostatic charge deposited on a side of said sticker print medium.” If this rejection is to be maintained, Applicant requests that it be indicated where the Longtin reference teaches or suggest the deposited charge on one side of the sticker print medium.

Moreover, Longtin fails to teach or suggest “a blank sheet of electrostatic print medium.” The Office Action argues that the stickers taught by Longtin were inherently blank before they were printed. (Paper No. 11, p. 4). However, even if true, this is insufficient. To meet the terms of claim 12, Longtin must teach a print medium that is *simultaneously* blank, covered on one side by a deposited electrostatic charge and joined with a protective backing over that charge. The burden is on the Office to demonstrate that at some time in the production of the roll of stickers taught by Longtin *all* of these conditions were met. This, the recent Office Action fails to do. There is no teaching or indication in Longtin that at some point the stickers were blank, charged and on a protective backing.

As noted before, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Longtin

cannot anticipate claim 12. Thus, the rejection of claim 12 and its dependent claims, based solely on Longtin, should be reconsidered and withdrawn.

The recent Office Action further rejected claims 1, 9 and 10 as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Floegel and U.S. Patent No. U.S. Pat. No. 2,293,887 to Chamberlain (“Chamberlain”). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

A method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker; and

depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

The outstanding Office Action acknowledges that Floegel does not teach or suggest “depositing an electrostatic charge on said sticker print medium with a charge donor,” where the “charge donor is separate from, and not a part of, the sticker print medium.” (Paper No. 11, p. 6). Consequently, the Office Action proposes to combine the teachings of Floegel with those of Chamberlain. According to the Office Action, “Chamberlain discloses depositing a charge to a print medium during mounting of the medium to a surface, wherein said charge donor is separate from, and not a part of, said sticker print medium.” (*Id.*).

As given in the Office Action, the motivation to combine the teachings of these two references “would have been to increase the strength of attraction or adhesion when mounting the medium.” (*Id.*). However, this would not be the effect of combining the teachings of Floegel and Chamberlain as proposed.

According to Floegel, a charge is developed by heating the print medium in the presence of an electric field to induce an electric dipole moment. (Col. 1, lines 57-63; and col. 3, lines 12-15). When the plastic sheet is cooled, the result is a “permanent electrostatic charge.” (Col. 1, line 58).

Under the most basic principles of electrostatics, this “permanent electrostatic charge” will repel any like charge. Consequently, if a “charge donor” were brought into contact with the electret sheet taught by Floegel, the permanent electrostatic charge on the sheet would repel and prevent the addition of any further like charge from the charge donor.

Thus, it is not true, as the Office Action suggests, that a separate charge donor as taught by Chamberlain could be used to increase the strength of the charge on the sheet taught by Floegel. The use of a charge donor with the sheet taught by Floegel would not be attempted by one of ordinary skill in the art. Therefore, there is no motivation in the prior art to combine the teachings of Floegel and Chamberlain as suggested in the recent Office Action.

Applicant notes that this argument was presented previously, but has not been responded to during the examination of this application. If this rejection is to be maintained, Applicant requests a response to this argument.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added). Consequently, the rejection of claims 1 and 10 based on the improperly combined teachings of Floegel and Chamberlain should be reconsidered and withdrawn. The same applies to the rejections of claims 2-4 and 9 which depend from claim 1 and which were also rejected based on the proposed combination of Floegel and Chamberlain.

Claims 16-19 were under 35 U.S.C. § 103(a) over the combined teachings of U.S. Pat. No. 2,293,887 to Chamberlain (“Chamberlain”) and U.S. Patent No. 3,589,507 to Greenberg et al. (“Greenberg”). Claim 25 was rejected under 35 U.S.C. § 103(a) over the combined

teachings of U.S. Pat. No. 4,992,121 to Rubino ("Rubino") and Greenberg. These rejections are respectfully traversed as follows.

Claim 16 recites:

An electrostatic sticker kit comprising
a kit including:
at least one blank sheet of an electrostatic sticker print medium; and
a charge donor, other than said sticker print medium, for depositing an
electrostatic charge on either side of said sticker print medium;
wherein said at least one blank sheet of sticker print medium and said charge
donor are packaged together in said kit.

In contrast, Chamberlain fails to teach or suggest the claimed kit. Chamberlain fails to teach or suggest a "blank sheet of electrostatic sticker print medium." Greenberg also fails to teach or suggest a blank sheet of electrostatic sticker print medium. Consequently, the combination of Chamberlain and Greenberg cannot teach or suggest the claimed kit.

Moreover, simply because Greenberg teaches photographic plates in a kit does not suggest that that a blank sheet of electrostatic sticker print medium and a charge donor should be packaged together in a kit.

Consequently, the combined teachings of Chamberlain and Greenberg utterly fail to teach or suggest the claimed "kit" including a blank sticker print medium and a charge donor.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, this rejection of claims 16-19 should be reconsidered and withdrawn.

Claim 25 recites:

A business method comprising providing an electrostatic sticker kit, said
providing an electrostatic sticker kit comprising providing a kit containing at least one
blank sheet of an electrostatic sticker print medium and a charge donor, other than
said sticker print medium, for depositing an electrostatic charge on either side of said

sticker print medium, wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are packaged together to form said kit.

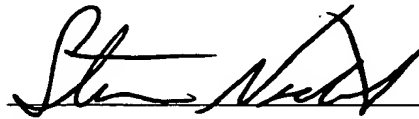
In contrast, Rubino fails to teach or suggest the claimed business method of providing an electrostatic sticker kit. Rubino fails to teach or suggest a blank sheet of electrostatic sticker *print* medium. Rather, Rubino teaches an “electrostatically chargeable intermediate sheet” that is used to adhere another sheet or object to a support surface. There is no teaching in Rubino of an electrostatic sticker print medium. Moreover, Rubino fails to teach or suggest packaging any materials together into a kit.

Similarly, as noted above, Greenberg also fails to teach or suggest a blank sheet of electrostatic sticker print medium. Moreover, simply because Greenberg teaches photographic plates in a kit does not suggest that a blank sheet of electrostatic sticker print medium and a charge donor should be packaged together in a kit or a business method of providing such a kit.

Consequently, the combination of Rubino and Greenberg cannot teach or suggest the claimed business method of providing a kit including a blank sheet of electrostatic sticker print medium and a charge donor. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, this rejection of claim 25 should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven L. Nichols', written over a horizontal line.

Steven L. Nichols
Registration No. 40,326

DATE: 22 December 2003

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)